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**REMARKS**

2        The Applicants respectfully request reconsideration and allowance of claims 1 through 37  
3        in view of the comments set forth below.

4

5        I.        **THE ENCLOSED TERMINAL DISCLAIMER OBVIATES THE DOUBLE**  
6        **PATENTING REJECTIONS**

7        The Examiner rejected claims 1-27, 29-31, and 33-36 under the doctrine of obviousness-  
8        type (nonstatutory) double patenting in view of claims 1 through 23 of U.S. Patent No.  
9        6,169,878. Enclosed with this response is a terminal disclaimer under 37 C.F.R. §1.321(c). The  
10      Applicants believe that this terminal disclaimer overcomes the nonstatutory double patenting  
11      rejections. Thus, the Applicants submit that claims 1-37 are all now in condition for allowance.

12

13        II.        **INFORMATION DISCLOSURE STATEMENT AND INFORMATION ON RELATED**  
14        **LITIGATION**

15        The Applicants are submitting under separate cover an Information Disclosure Statement  
16        under 37 C.F.R. §1.97(c) to disclose additional prior art references that were cited in litigation  
17        involving the two parent cases for the present application, U.S. Patent No. 5,761,605 (the “605  
18        patent”) and U.S. Patent No. 6,169,878 (the “878 patent”). This litigation, styled Northpoint  
19        Technology, Ltd. v. MDS America, Inc. and MDS International, S.A.R.L. in the United States  
20        District Court for the Southern District of Florida (the “litigation”), involved claim 8 of the 605  
21        patent and claims 1 and 7 of the 878 patent (the “asserted claims”). The defendants in the  
22        litigation (the “litigation defendants”) argued that five references independently anticipated the

1 asserted claims, and further argued that the asserted claims were obvious in view of the five  
2 references. These references are:

- 3 1. Rand Corp., *The Technology Potentials for Satellite Spacing and Frequency*  
4 *Sharing* (1968), (the "Rand reference" or "Rand");
- 5 2. Eur. Radiocom. Comm., *Sharing the Band 11.7 Ghz Between ENG/OB and*  
6 *Direct-to-home TV Broadcasting Satellites* (ERC Rep. No. 37, 1995), (the "ERC  
7 reference" or "ERC");
- 8 3. ITU Radio Regs., Art 27 (1982), (the "ITU reference" or "ITU");
- 9 4. Scheeren, *Interference Reduction Techniques for Earth Stations* (1988), (the  
10 "Scheeren reference" or "Scheeren"); and
- 11 5. Hult, *Sharing the UHF Between Space and Terrestrial Services* (1970), (the "Hult  
12 reference" or "Hult").

13 At the conclusion of the trial, the jury found that the asserted claims (claim 8 of the 605  
14 patent and claims 1 and 7 of the 878 patent) failed to comply with the enablement requirement  
15 and were indefinite under §112, that the asserted claims were anticipated by the prior art, and that  
16 the asserted claims would have been obvious in view of the prior art. The final judgement in this  
17 U.S. District Court case is currently pending appeal by the patent owner to the U.S. Court of  
18 Appeals for the Federal Circuit.

19 The Applicants submit that claims 1 through 37 in this application are clearly allowable  
20 over the five references cited above and in the IDS submitted under separate cover.

21

22 A. The Rand Reference

23 The Applicants understand the litigation defendants relied on two sentences from the  
24 Rand reference to support the litigation defendants' contention that the asserted claims were  
25 anticipated by the Rand reference. The two sentences are as follows:

26 "Three types of stations must be considered in analyzing such spectrum sharing:  
27 terrestrial microwave repeaters and terminals, satellite repeaters, and earth-station terminals."  
28 (Section V of the Rand reference)

1            "If the relative alignment of terrestrial microwave relay and satellite relay antennas is  
2        controlled so that either or both do not point at the other, the mutual interference potential could  
3        be significantly reduced." (Page 94 of the Rand reference)

4

5        B.      The ERC Reference

6            The Applicants understand the litigation defendants relied on a single passage from the  
7        ERC reference to support the litigation defendants' contention that the asserted claims were  
8        anticipated by the ERC reference. This passage reads:

9            "Whilst the density of domestic receiving installations in the locality of the cordless  
10      camera site remains low, co-existence between them and the low power outgoing link from the  
11      camera, may be considered possible." (Page 4 of the ERC reference)

12

13        C.      The ITU Reference

14            The Applicants understand the litigation defendants relied on a single footnote from the  
15      ITU reference to support the litigation defendants' contention that the asserted claims were  
16      anticipated by the ITU reference. This passage reads:

17            "For their own protection receiving stations in the fixed or mobile service operating in  
18      bands shared with space radiocommunication services (space-to-Earth) should also avoid  
19      directing their antennae towards the geostationary-satellite orbit if their sensitivity is sufficiently  
20      high that interference from space station transmissions may be significant." (Page RR 27-2 of the  
21      ITU reference)

## 1        D.     The Scheeren Reference

2            It is noted that the Scheeren reference was not in evidence in the above-described  
3            litigation. The litigation defendants withdrew the Scheeren reference after their expert had  
4            testified about the reference. The Applicants understand that the litigation defendants argued that  
5            the discussion at pages 3 and 4 of the Scheeren reference anticipated the asserted claims.

6

## 7        E.     The Hult Reference

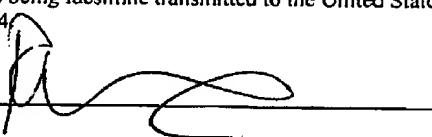
8            The Applicants understand that the litigation defendants argued that the Hult reference  
9            inherently disclosed the antenna directional reception range limitations in the asserted claims.  
10           However, the Hult reference does not mention the use of antennas with a directional reception  
11           range, but instead suggests using small adaptive antenna arrays that have the capability to null  
12           out or not accept or absorb energy from unwanted interfering signals.

13

1        III.    CONCLUSION

2            For all of the above reasons the Applicants respectfully request reconsideration and  
3        allowance of claims 1 through 37.

4            If the Examiner should feel that any issue remains as to the allowability of these claims,  
5        or that a telephone conference might expedite allowance of the claims, the Examiner may  
6        telephone the Applicant's attorney Russell D. Culbertson at the number listed below.

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8            Respectfully submitted,  
9  
10            The Culbertson Group, P.C.  
11  
12  
13            Dated: September 29, 2004  
14  
15            By:   
16            Russell D. Culbertson, Reg. No. 32,124  
17            Russell Scott, Reg. No. 43,103  
18            Trevor Lind, Reg. No. 54,785  
19            1114 Lost Creek Blvd., Suite 420  
20            Austin, Texas 78746  
21            512-327-8932  
22            ATTORNEYS FOR APPLICANT  
23  
24  
25  
26            I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, (Fax  
27            No. 703-872-9306) on September 29, 2004.  
28  
29  
30            Reg. No. 32,124, Russell D. Culbertson  


CERTIFICATE OF FACSIMILE

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